

Supreme Court, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1976

No. 76-1109

FOSTER GRANT CO., INC.,

Petitioner,

vs.

ILLINOIS TOOL WORKS, INC.,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT.**

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner Foster Grant Co., Inc. (Foster Grant) respectfully prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit in the above-entitled case.

OPINIONS BELOW.

The December 2, 1976 opinion of the Court of Appeals has not yet been reported; however, it is reprinted in the separately bound Appendix at pages A1 to A26. The March 4, 1974 opinion of the District Court for the Northern District of Illinois is reported at 395 F. Supp. 234, 181 U. S. P. Q. 553 (N. D. Ill. 1974) and is reprinted in the Appendix at pages A28 to A78.

JURISDICTION.

The judgment of the Court of Appeals was entered on December 2, 1976 (A27). A timely Petition for Rehearing and Suggestion for Rehearing *En Banc* was denied on December 30, 1976 (A27). The jurisdiction of this Court is invoked pursuant to 28 U. S. C. § 1254(1). The basis of jurisdiction in the District Court was 28 U. S. C. § 1338(a) and 35 U. S. C. §§ 271 and 281.

INTRODUCTORY STATEMENT.

This is a patent infringement action involving three patents of Respondent Illinois Tool Works (ITW). All three patents were previously held valid and infringed by the same courts whose decisions underlie the present petition. The patents and the prior reported cases are identified in the Court of Appeals opinion at A2-A3.* In this action, the District Court held the patents valid and infringed by Petitioner Foster Grant (A76-A77).

The Court of Appeals purported to base its affirmance in this case under its *Rovico*** and *Howmett**** decisions characterizing them as "but an application of the doctrine of *stare decisis*." However, the attempted application of *stare decisis* in this case is faulty for the very reasons noted by Judge Hamley of the Ninth Circuit in *Safe Flight Instrument Corp. v. McDonnell-*

* Additionally, ITW filed suit against Scott Paper Company, American Can Company, Phillips Petroleum, and Owens Illinois; all of which were brought in the Northern District of Illinois and there identified by Nos. 69 C 482, 483, 484 and 485 respectively.

** *American Photocopy Equipment Co. v. Rovico*, 384 F. 2d 813, 815-16 (7th Cir. 1967) *cert. denied*, 390 U. S. 945 (1967), which held that once there has been a judicial determination of validity, the party challenging validity in a later action in the same court has the burden of presenting "persuasive new evidence" of invalidity and demonstrating that there is a "material distinction" between the cases.

*** *Mercantile National Bank of Chicago v. Howmett Corp.*, 524 F. 2d 1031, 1032 (7th Cir. 1975) *cert. denied*, 424 U. S. 957 (1976).

Douglas Corp., 482 F. 2d 1086 (9th Cir. 1973), *cert. den.*, 414 U. S. 1113 (1973) where he said:

"But the respect which should be accorded prior adjudications as to the validity of a patent *does not*, absent estoppel running against the parties to the prior litigation, *supplant the primary duty of a court to dispose of cases according to the law and the facts of the particular case before it.* . . ." 482 F. 2d at 1090.*

In affirming, Judge Hamley stressed, as important, "that the district court *rigidly adhered* to the rules and criteria of the Supreme Court" . . . and made "[a]ll of the *factual inquiries required under the Graham decision.*" (482 F. 2d at 1092).

Contrast this with the present case, where the Court of Appeals specifically noted that the District Court did not make the "step-by-step analysis required by *Graham v. John Deere*". Here, the Court of Appeals also ruled that important findings of fact made by the District Court were clearly erroneous. However, relying on its *Rovico* rule, the Court of Appeals simply ignored many new facts, its own precedents and other important principles of law laid down by this Court. Clearly that is not *stare decisis* and, in application of the governing law, there is a marked conflict between the Courts of the Seventh and Ninth Circuits.

Moreover, since these combination patents may well never be litigated in another Circuit, Petitioner respectfully requests this Court, in the exercise of its supervisory powers, to review this case and the application of the *Rovico* rule to it by Writ of Certiorari.

THE QUESTIONS PRESENTED.

As to Certiorari Policy.

1. Should a patent owner be allowed to avoid the effect of estoppels arising from positions it took to win an earlier patent infringement case while at the same time invoking the *stare*

* Emphasis added throughout unless otherwise indicated.

decisis effect of that case against a subsequent Defendant charged with infringing the same patents, who was not a party to the earlier case, and thus expand the scope of his limited monopoly?

2. Should not this Court grant certiorari to provide much needed guidance concerning the proper interpretation of the requirements of Section 112 of the patent laws (35 U. S. C. 112) on which this Court has not spoken since its enactment 25 years ago?

3. Should not this Court grant certiorari and now consider Section 112 in view of

a) the change in the patent laws with respect to the mandatory "best mode" requirement of Section 112 adopted by Congress in 1952; and

b) the failure of both courts below to even consider the inventor's non-disclosure of the "best mode" contemplated by him for carrying out his invention at the time of filing his application for a patent?

4. Can the *Rovico* case as applied by the Seventh Circuit, be allowed to abrogate the effect of the decisions of this Court on "file wrapper estoppel" and "combination patents" and thus lower the standard of patentability for a combination of old elements that produces no synergistic effect or unobvious result?

On the Merits.

5. Did not the Court of Appeals err as a matter of law in affirming a new definition for the "rim", a key element of the '213 combination patent claims, to find infringement, while disregarding the strict requirements of 35 U. S. C. § 112, where the patent specification contains absolutely no mention of the term "rim" and the evidence at trial established that the "best mode" of carrying out the invention as contemplated by the inventor was not disclosed in the '213 patent application?

6. Did not the Court of Appeals err as a matter of law in affirming, under *Rovico*, the patentee's new, narrowed definition

of "rim", which enlarged the scope of the '213 patent claims, when it failed to re-evaluate all the prior art and evidence?

7. Did not the Court of Appeals err as a matter of law in affirming the validity of the '139 patent, under *Rovico*, when the District Court said it made its decision "without reliance on the prior ITW decisions" and yet neither court made the step-by-step analysis of the new prior art required by *Graham v. John Deere*, 383 U. S. 1 (1966) nor compared the new prior art with either the prior art previously considered or with the products previously held as infringements; thus repudiating the fundamental principles of patent law laid down by this Court in *Smith v. Hall*, 301 U. S. 216 (1937), and *Knapp v. Morss*, 150 U. S. 221 (1893)?

Because of the *Rovico* rule, it is necessary to consider the decisions in the present case in light of the prior *Continental Can** case. Regrettably, this makes the petition longer and the material necessarily included in the Appendix more voluminous than Petitioner would like. In view of this, Petitioner will limit its discussion to the '213 and '139 patents since a discussion of these two patents raises all of the legal issues that Petitioner respectfully requests this Court should review. The legal issues involving the '360 patent are the same or very similar and according, if this Court grants certiorari. Petitioner requests leave to also present argument in its Brief as to the invalidity of the '360 patent.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED.

This case involves Article I, Section 8, Clause 8 and the "Due Process" Clause of Amendment V of the United States Constitution and Sections 101, 102, 103, 112, 120 and 121

* *Illinois Tool Works, Inc. v. Continental Can Company*, 273 F. Supp. 94 (N. D. Ill. 1967), *aff'd.*, 397 F. 2d 517 (7th Cir. 1968). Copies of these decisions are reprinted in the Appendix at A79-A144 and A145-A155.

of the Patent Code of 1952 (35 U. S. Code §§ 101, 102, 103, 112, 120 and 121). These Constitutional provisions and statutory sections are set forth in the separately bound Appendix, beginning at A156.

STATEMENT OF THE CASE.

Petitioner Foster Grant and Respondent ITW are manufacturers of disposable, thin-walled plastic containers and lids of the type which are alleged by ITW to be "inventions" covered by the patents in suit. They are mass-produced by the prior art thermoforming process* and are universally used for packaging food such as cottage cheese, sour cream, yogurt, meats, salads, etc. To save space, the empty containers and lids are respectively stored and shipped in nested or stacked relationship (*i.e.* stacks of 50-100 containers or lids). To prevent such nested articles from wedging or jamming together, such that they cannot be easily separated, each article has annular ridges formed into its side to abut the ridges of adjacent articles in the stack. In the patents involved here, such ridges are dignified as "stacking devices". Because the thin wall plastic material at the upper end is flexible, such containers and lids are made with a reinforcing "rim".

Illustrated on fold-out Plate I are drawings from two pertinent prior art patents (Flack and Aldington) showing plastic containers and lids in stacked relation. In each case, the uppermost "stacking device" is colored green and the "rim" (as previously defined by ITW) is colored red. The combination of Flack and Aldington is also shown on Plate I.

In 1957, Respondent ITW entered the thermoformed container business and its engineer, Bryant Edwards, designed a nestable plastic cup, an illustration of which appears on Plate

* "Thermoforming. A thermoplastic sheet, heated to its softening point, can be forced against the contours of a mold by air pressure, forming a desired shape after cooling". 14 The New Encyclopedia Britanica, Macropedia (15th Ed., 1975), p. 521.

II. By slanting a short portion of the wall inwardly, the cup was formed with a "Z-shaped" stacking device located at the rim. Such Z-shaped stacking devices were old in the art (see Aldington Plate I). Edwards' rim-stacker design made this cup uncomfortable to drink from and this rim configuration was unacceptable to ITW's customer. Accordingly, Edwards moved the Z-shaped stacker down to a location in the cup sidewall about one-half inch below the rim. Respondent ITW has contended—thus far successfully—that this change in location of the Z-shaped stacker from the rim to below the rim amounted to "invention". This is the subject of ITW's patent No. 3,139,213 for "Nestable Cup" ('213 patent), Figs. 2 and 3 of which are illustrated on Plate II.

The '213 Patent.

Edwards' first Nestable Cup application (PX 5) was filed November 29, 1957. It contained one sheet of drawings with four figures which correspond to Figs. 1-4 of the '213 patent. The word "rim" was not used in either the specification or the claims of this application. The first application (PX 5) was abandoned after Edwards filed a continuation-in-part application (PX 7) October 29, 1958. The second application included three sheets of new drawings comprising Figs. 5-23 of which Figs. 18, 20 and 23, respectively, became Figs. 6, 7 and 8 of the '213 patent. The term "rim" appeared for the first time in the specification of this application where it was equated to "lip" but it was not used in the claims until they were finally amended on December 4, 1962. The second application (PX 7) resulted in the '360 patent after a divisional application (PX 6) directed to the '213 "invention" was carved out and filed December 13, 1962. The term "rim" does not appear in the specification of the divisional application but it was used in the claims initially filed in the same manner it had been used in the claims which were allowed in the '360 patent. Following further extensive amendments purporting to dis-

tinguish the '213 patent application claims over the prior art Flack and Aldington references illustrated herein the '213 patent issued July 30, 1964.

Two months before Edwards filed his second Nestable Cup application (PX 7) he filed for another patent (DX 75) disclosing how to roll the depending rim of the cup so the rim would not have a sharp lower edge that could cut a cup user. Figs. 3 and 4* from this patent (DX 75) appear on Plate II. Clearly, the Figure 4 embodiment with the rolled over rim to prevent cuts was the best mode contemplated by Edwards in August 1958.** However, Edwards did not disclose this "best mode" of making the rolled rim in either of his subsequently filed Nestable Cup applications (PX 7 and PX 6).

In 1966, Illinois Tool Works filed suit in the Northern District of Illinois against Continental Can Company and Judge Decker held the '213 patent valid and infringed (A143). The Court of Appeals affirmed (A151). ITW also filed suits against seven other defendants,*** comprising virtually the entire thermoformed container industry, all in the Northern District of Illinois, alleging infringement of the '213 patent.

Because of the Seventh Circuit's *Rovico* rule and the fact that the subsequent courts totally ignored ITW's changes of position regarding its patent claims, the later suits against *Sweetheart*, **** *Solo****** and this Petitioner were successful. The other cases were dismissed when the defendants took licenses from ITW.

Based on the positions taken by ITW to obtain its favorable *Continental Can* decision, Petitioner redesigned its containers

* In the brief descriptions of these figures "rim" and "lip" are used synonymously (Col. 1, ll. 55-59).

** Note that rolling the rim also establishes the height (axial extent) of the finished rim.

*** See case cited at A2 and the footnote to page 2, *supra*.

**** *Illinois Tool Works Inc. v. Sweetheart Plastics, Inc.*, 306 F. Supp. 364 (N. D. Ill. 1969), *aff'd*, 436 F. 2d 1180 (7th Cir. 1971).

***** *Illinois Tool Works Inc. v. Solo Cup Co.*, 179 U. S. P. Q. 322 (N. D. Ill. 1973).

so that the upper stacking shoulder was *not positioned below and spaced axially from the rim*, as the '213 claims require. Rather, the upper shoulder, as in Flack and Aldington, merges into the rim structure. Petitioner at trial, therefore, asserted the defense of non-infringement based upon 1) file wrapper estoppel, 2) ITW's prior position in *Continental Can*, 3) the usual definition of "rim" previously employed by Edwards and by others and 4) the failure of the '213 patent to satisfy the requirements of 35 U. S. C. § 112.

The District Court ignored these defenses and found infringement based on a new definition of the claim element "rim" advanced by ITW which was not only unsupported by the patent specification* but was in direct conflict with common usage and the prior prosecution and litigation history of the '213 patent. The District Court even held that the prior application (PX 7) upon which the '213 patent was based—wherein "rim" was used and equated to "lip"—was irrelevant to claims of the '213 patent.

Reprinted on Plate II is ITW's drawing of one of the accused Foster Grant's containers, on which ITW designated its new interpretation of the word "rim" as used in the '213 claim.

The Court of Appeals here gave this critical element of the claim yet another definition which was not only in conflict with the prosecution history in the Patent Office and ITW's prior position in *Continental Can* but it also differed from ITW's new definition and the District Court's decision in the instant case. Incredibly, the Court of Appeals concluded that the portion called "lip" by the District Court was really the "skirt" and the portion designated "rim" in the above drawing was really "upper rim", a term for which there is no antecedent in the '213 patent or in any of its parent applications (PX 5 and 7). Infringement was affirmed based upon this third and heretofore unknown definition.

* The word "rim" does not appear in the specification.

The '139 Patent.

The second patent involved in this Petition is U. S. 3,061,139 entitled "Self-Venting Package" (the '139 patent) issued on October 30, 1962 upon an application filed on March 14, 1960. The '139 patent relates to plastic containers and lids intended primarily for packaging food on automatic filling and capping machinery. In this case, as in *Continental Can*, all the containers held to infringe the '213 patent were also held to infringe the '139 patent when those containers were used with lids to form packages for cottage cheese, etc.

In *Continental Can*, the container had an internal groove at its upper end and the lid had a projecting bead designed to snap-fit into the container groove. Four small notches were formed in the bead of the lid to permit the escape of air from under the lid during capping.

Petitioner's lids have no such notches. Instead, the air compressed under the lids during the automatic capping procedure is vented through vertical grooves in the containers.

Whereas ITW had obtained its '139 patent and in *Continental Can* successfully asserted it on the basis that the venting was needed to relieve pressure caused by gas generated by packaged cottage cheese, Petitioner here proved that no such phenomenon occurred and that the venting which is required is only that to prevent air from being trapped in the package during capping*. If the trapped air is not eliminated during capping, it sometimes causes the lid to "pop" off.

* ITW's own field service reports showed that ITW knew that it was air trapped at the time of the capping operation that caused the "lid popping" problem, which ITW was still experiencing at the time of the *Continental Can* suit. ITW failed during discovery to produce such reports for Petitioner in response to specific Rule 34 Requests for such documents. A former ITW field service engineer had copies of his reports which were introduced into evidence at trial but ignored by both the District and Circuit Courts.

In the instant case, Petitioner also proved* that Kent Plastics Co. of Evansville, Indiana had, more than a year before the filing date of the '139 patent, manufactured and sold thousands of all plastic, thermoformed, thin-walled cottage cheese containers and lids with notches in the lid bead to prevent air from being trapped during capping. Petitioner also proved the problem of trapping air during capping was long recognized in the art.

Petitioner's effort to introduce testimony and other evidence demonstrating that the prior art packages and the infringing *Continental Can* packages were the same was frustrated when the trial court sustained ITW's objection to such evidence. The Court of Appeals surprisingly failed to find error in such an adverse evidentiary ruling which prevented Petitioner from demonstrating the applicability of this Court's classic pronouncement "that which infringes, if later, would anticipate if earlier", *Knapp v. Morss, supra*.

Because the physical samples of the prior art Kent container and lid (admitted in evidence) and the infringing *Continental Can* container and lid (refused in evidence) can not themselves be submitted here, Petitioner has had made, for presentation to this Court, the illustrative drawings** appearing on Plate III.

REASONS FOR GRANTING THE WRIT.

I. As to the Certiorari Policy.

The patents involved here have been in continuous litigation in the courts of the Seventh Circuit for the last ten years. The District Court in *Continental Can* held the '213 and '139 patents

* The trial court found that Petitioner had not proved that the Kent packages were prior art. The Court of Appeals held that the trial court's finding was clearly erroneous.

** No contention is made that these illustrations are drawn to scale or are themselves evidentiary matter. Rather, they are submitted simply as illustrative of the physical samples Petitioner sought to have the trial court compare.

valid and infringed although these combination patents were characterized then as being "quite limited" and "should be narrowly construed". The Court of Appeals affirmed.

Girded with its *Continental Can* success and relying on the Seventh Circuit's *Rovico* rule to shield it against subsequent defendants' attacks on the validity of these patents which define combinations of old elements, ITW summoned all of its competitors in the thermofforming container industry, who were not willing to take a license, to the U. S. District Court in Chicago.

As it brought the litigated cases to trial seriatim, ITW urged an ever-expanding scope for the claims of these patents, much like a snowball rolling downhill in untrodden snow. For instance, Judge Decker in *Sweetheart*, *supra*, held flat bottom containers were not covered by the '213 patent, but that result did not prevent ITW from urging that similar flat bottomed cups were willful infringements in *Solo*, *supra*, and succeeding. In the present case, ITW has now changed its definition of "rim" and had it accepted by the Courts of the Seventh Circuit, which have affirmed under *Rovico* with total disregard for such changes in ITW's position and the validity of the patents in view of the prior art.

Having in mind that this Court did not reach the Section 112 issue in its recent decision of *Dann v. Johnston*, 425 U. S. 219 (1976), it is respectfully submitted that the instant case presents an appropriate opportunity for the Court to rule on the requirements of this Section. The first sentence requires that:

"The specification shall contain a *written description of the invention* and of the manner and process of making and using it, *in such full, clear, concise, and exact terms* as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, *and shall set forth the best mode contemplated by the inventor of carrying out his invention.*" (See A157)

Since this Court has not spoken on either the "written description" or "best mode" requirements of Section 112, as rewritten by Congress in 1952, granting certiorari here would enable this Court to provide needed guidance to the lower courts in the proper interpretation of this Section. Petitioner submits, this Court should now reaffirm that its pre-1952 decisions continue to control the "written description" requirement of Section 112. *Beidler v. United States*, 253 U. S. 447 (1920), *Schriber-Schroth Co. v. Cleveland Trust Co.* (Schriber I), 305 U. S. 47 (1938) and *Universal Oil Products Co. v. Globe Oil Co.*, 322 U. S. 471 (1944).

Similarly, it has been well over sixty years since this Court said "An inventor must describe what he conceives to be the best mode . . ." *The Paper Bag Patent Case*, 210 U. S. 405 at 418 (1908). At that time the Patent Statute* only required disclosure of the "best mode" contemplated by the inventor in a patent application directed to a "machine". However, in 1952 Congress changed the law to extend the "best mode" requirement to *all* types of invention.** As pointed out by Federico*** "this requirement is partly derived from and replaces the first defense specified in old R. S. 4920 . . . as well as being a revision and extension of the old clause which related only to machines". The defense referred to arose *inter alia* when:

"[F]or the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, . . ."

Thus telling the "whole truth" is now part of the "best mode" requirement of Section 112. The effect of the failure of the courts below to hold Edwards to the mandatory "best mode" requirement of Section 112, results in a direct conflict with the courts of the First and Sixth Circuits. See *Dale Electronics, Inc.*

* R. S. 4888; Act July 8, 1970, c. 230 § 26, 165 Stat. 201.

** 35 U. S. C. A. § 112, revisers note at p. 5.

*** 35 U. S. C. A. §§ 1-110 at p. 25.

v. *R. C. L. Electronics, Inc.*, 488 F. 2d 382 at 389 (1st Cir. 1973), *Union Carbide Corp. v. Borg-Warner Corp. et al.*, decided January 27, 1977 slip opinion No. 75-2263 (6th Cir. 1977).

By granting certiorari, this Court can instruct the Circuit Courts that the "best mode" requirement referred to in the *Paper Bag Patent Case*, *supra*, now applies under Section 112 to all types of patent applications including the '213 patent involved here. Petitioner further submits this Court should now declare that the requirements of Section 112 must be "strictly observed" just as it has held with respect to the requirements of Section 101, *Brenner v. Manson*, 383 U. S. 519 (1966) and Section 103, *Graham v. Deere*, *supra*, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U. S. 57 (1969); *Sakraida v. Ag Pro, Inc.*, 425 U. S. 273 (1976).

While it is unlikely there will be a conflict between circuits on the patents, this Court pointed out in *Schriber-Schroth Co. v. Cleveland Trust Co.* (Schriber I), *supra*, that it had granted certiorari on a showing that:

"... [N]otwithstanding the doubtful validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit."

To the same effect is *Exhibit Supply Co. v. Ace Patents Co.*, 315 U. S. 126 (1942). We respectfully urge the Court to grant certiorari here because of the concentration of suits against the thermoforming industry brought by ITW in the Seventh Circuit.*

Further, in the exercise of its supervisory powers over the Circuit Courts under Rule 19 of this Court, we submit, the time is ripe for this Court to review the *Rovico* rule as applied by the Courts of the Seventh Circuit. In doing so, this Court will surely find that the Seventh Circuit has permitted ITW to use *Rovico* not merely as a shield protecting it against the reassertion of the

* See A2 and footnote at p. 2, *supra*.

same evidence of invalidity, but also as a sword against subsequent defendants and to carve out an ever expanding scope for its patent monopolies which should now be declared invalid and illegal. Permitting these ever changing positions and ignoring the estoppels created by ITW in the *Continental Can* case disregards, we believe, the important principles of estoppel and due process enunciated by this Court in *Blonder-Tongue v. University of Illinois Foundation*, 402 U. S. 313 (1971). We recognize that estoppel there was applied against an unsuccessful patentee, i.e., his patent had been declared invalid in the prior case. But, should not the estoppel rationale of *Blonder-Tongue* be applied, even more stringently, against a patentee who was successful in upholding the validity of his patent in the prior case? And, should not the rationale of "file wrapper estoppel" which this Court has long recognized as being created by changes of position by the patentee to avoid prior art before the Patent Office, *Exhibit Supply Co. v. Ace Patents Corp.*, *supra*, *Graham v. John Deere*, *supra*, be fully applicable to patentees, who have in one court case succeeded in enforcing their limited monopoly based on a particular construction of claim language, but who seek in a later case to avoid the thrust of the earlier position?

II. As to the Substantive Issues.

Before discussing the disclosure requirements of Section 112, the issues dealing with "Estoppel" and "A Combination of Old Elements" as to the '213 patent are discussed below in order to lay a more complete foundation for the meaning of the critical claim element "rim".

1. Estoppel as to the '213 Patent.

The changes to the '213 patent claims that are crucial here are set out at pages A159-A162 of the Appendix. Claim 1, after being rejected on Flack was changed extensively and rewritten. Those changes italicized at A159 did not distinguish over Flack

but those at A160 in bold face type did. This claim was rejected on Aldington and then was extensively amended (See A161-A162). While the italicized changes at A161-162 distinguished over Aldington, they did not distinguish over Flack. Only the bold face changes in amended claim 10 (which, as rewritten, became claim 1 of the '213 patent), distinguish over both Flack and Aldington. If, from reading the file wrapper, there were any doubt—and we submit there is not—as to why ITW made these bold face changes, it is completely dispelled by ITW's characterization of these references in *Continental Can*, ITW characterized Flack as a "rim stacker" and about Aldington said the "rim" is defined as

"an inverted U-shaped formation comprising the skirt 11 and wall 5"

As such, of course, in neither Aldington nor Flack was the stacking means:

"positioned below AND SPACED AXIALLY FROM said upper RIM"

as the '213 claims were amended to require. Likewise in *Continental Can*, ITW's characterization of Aldington and Flack precluded either of these references from having an internal "WALL SURFACE ADJACENT AND ABOVE SAID INTERNAL SHOULDER MEANS" as also required in the allowed '213 claims.

In *Schriber-Schroth Co. v. Cleveland Trust Co.*, (Schriber II), 311 U. S. 211 (1940), this Court held:

"Where the patentee in the course of his application in the patent office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed." 311 U. S. at 218.

Also directly on point are this Court's decisions in *Exhibit Supply Co. v. Ace Patents Corp.*, *supra*, at 37 and *Graham v. Deere*, *supra*, at 33.

Certiorari should be granted, we submit, so this Court can instruct the Court of Appeals for the Seventh Circuit in the proper application of its *Rovico* Rule without evasion of the established principles of estoppel and due process.

2. A Combination of Old Elements in '213.

If file wrapper estoppel is ignored, and ITW is permitted to change to a new definition of "rim", the '213 patent claims define no more than a combination of old elements. Pictured on Plate II is the ITW drawing of the accused containers with the legends applied thereto as accepted by the District Court and the Court of Appeals. Also pictured on Plate II is the pertinent portion of Fig. 2 of Aldington with those same legends similarly applied.

Structural and Functional Identity.

Combining Flack and Aldington produces every element of the '213 claims. All that need be done is to replace Flack's vertical stacker and rim with Aldington's Z-stacker, wall portion and rim as identified under ITW's new definition. Such a combination of old elements in the prior art is illustrated on Plate I.

In *Continental Can*, ITW made much of the alleged "resiliency" of Edwards' Z-shaped stacker located below the rim. After a lengthy discussion Judge Decker held that ITW was entitled to the "resiliency" claimed for the Z-shaped stacker in the '213 patent because thin-walled plastic is inherently resilient and Edwards had disclosed a Z-stacker in his first application, *ergo* Edwards' Z-stacker was inherently resilient (A91-A93).

Flack was distinguished both in the Patent Office and in *Continental Can* because Flack's vertical stacker was said to

be rigid, even though it was plastic. The last clause of claim 1 of the '213 patent was added to distinguish over Flack (see bold face at A160). No such argument was made in the Patent Office with respect to Aldington.

In *Continental Can*, Judge Decker did not give the Aldington reference the same benefit of "inherent resiliency" that he had extended to the '213 patent. Instead he said

"There is no reference in Aldington to resiliency of a stack of lids. Furthermore, the Z-configuration comprises the entire side wall of the lid resulting in different structural interrelationships than in the '213 invention." 273 F. Supp. at 115. (A113)

The latter point, of course, is no longer true in view of ITW's change of position which now results in the "structural identity" discussed above.

As to the first sentence quoted above, the Aldington reference repeatedly characterizes the lids as "flexible and resilient" and even mentions the "inherent flexibility and resiliency of the cover", but these properties are not directly mentioned in Aldington's discussion about stacking.

In the present case, actual samples of the prior art Aldington lids (DX 135A-C) were introduced in evidence. Aldington himself and his coworker Rath testified how these lids were stacked and that the "resilience" of the stacking mechanism permitted them to be compression packed (R. 1487, 1488, 1554, 1555). Even under the *Rovico* rule, this was plainly "persuasive new evidence of invalidity" and a "material distinction" over what Judge Decker was prompted to find on the earlier record before him. Had Judge Decker appreciated these newly presented facts, we submit, he probably would have found the '213 patent invalid even under the liberal test of "invention" which he applied (See A119-A120).

However, we need not speculate on this. Since Judge Decker's decision in *Continental Can*, this Court has repeatedly ad-

monished that the standard of patentability for a combination of old elements is a strict one and under the Constitution it cannot be ignored. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, *supra*, *Sakraida v. Ag Pro, Inc.*, *supra*.

Moreover, on the facts of this case, as now established the combination of elements defined in the '213 claims produces no "synergistic effect". *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, *supra*, *Sakraida v. Ag Pro, Inc.*, *supra*, or any other "nonbovius" result. *Graham v. John Deere Co.*, *supra*. The "rim", "wall portion" and "Z-stacker" of Aldington are the same structurally and functionally as those elements in the '213 claims now defined by ITW. When these old elements are united in the Flack container (see Plate I), the '213 claims read directly upon it.

The Court of Appeals noted that the District Court in the present case paid only "lip service" to the analytical approach required by this Court in *Graham v. John Deere Co.*, *supra*, and instead gave substantial emphasis to the secondary factors. However, those matters "without invention will not make patentability". *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950), *Anderson-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, *supra*, and *Sakraida v. Ag Pro, Inc.*, *supra*.

3. The Section 112 Requirements.

In the sections above on "file wrapper estoppel" and "a combination of old elements" our arguments have assumed, *arguendo*, that the '213 patent specification and claims satisfy the statutory requirements of Section 112 of the Patent Laws.* We respectfully submit they do not and that the Courts below clearly erred as a matter of law on this issue.

As will be appreciated from the preceding discussion, the recitations of "rim of predetermined axial extent", "upper rim"

* 35 U. S. C. § 112 reprinted at A157.

and "rim portion" as used to claim the '213 "invention" are critical to both the issues of validity and infringement of the '213 patent. Under such circumstances, it should be sufficient to point out that the word RIM *does not appear* in the specification of the '213 patent. Not even once, let alone with a "full, clear and concise written description" thereof in the context of any of the three ways that it is used in the claims. Petitioner submits this Court's pre-1952 decisions* should be reaffirmed as controlling the "written description" requirement of Section 112.

The word "rim" does appear in Edwards' 1958 patent application (PX 7) out of which the '213 patent application (PX 6) was divided. "Rim" is there used synonymously with "lip". If "rim" in the '213 claims means something different than what it meant in that parent application, ITW is not entitled to rely on the 1958 filing date of that application under Section 120.** Then the '213 patent is invalid under 35 U. S. C. § 102(b)*** in view of ITW's sales of "nestable cups", as defined by the '213 claims, well more than one year before the 1962 filing date for the '213 application.

Petitioner thought that the Section 112 issue and the corollary issues under Sections 120 and 121 were controlled by such prior Seventh Circuit cases as: *Universal Oil Products Co. v. Globe Co.*, 137 F. 2d 3 (7th Cir., 1943), *aff'd* 322 U. S. 471 (1944), *Bendix Corp. v. Balax, Inc.*, 421 F. 2d 809 (7th Cir. 1970), and *Frantz Mfg. Co. v. Phenix Mfg. Co.*, 457 F. 2d 314 (7th Cir. 1972), which were cited in its Brief on Appeal. However, the Court below ignored these important precedents and those of this Court cited at p. 13 in what, this Petitioner submits, is clearly a misapplication of *stare decisis*. Judicial economy and stability of law are not served when a Court makes decisions, such as this, in total disregard of the applicable principles of law.

* See cases cited at p. 13, *supra*.

** Reprinted at A158.

*** Reprinted at A156.

In the present case the failure of Respondent, ITW, to disclose the "best mode" was specifically pleaded, evidence was submitted at trial and the issue was argued, with citation of authority, in Petitioner's Brief After Trial and on Appeal. It directly concerns the best mode contemplated by Edwards of carrying out his "invention" as defined in the '213 patent claims. At least by August, 1958 Edwards knew this "best mode" to include a "rolled rim" such as made on the machine which is now disclosed in his patent No. 3,096,546 (DX 75).* Yet, two months later when Edwards filed the second "Nestable Cup" application (PX 7) and for the first time used the word "rim" in the specification of any of the applications leading to the '213 patent, he withheld the important information that the "rolled rim" was the "best mode" contemplated by him of carrying out this element of his claimed invention.

By granting certiorari, this Court can instruct the Circuit Courts that the "best mode" requirement referred to in the *Paper Bag Patent Case, supra*, now applies under Section 112 to all types of patent applications including the '213 patent involved here.

4. That Which Infringes if Later Anticipates if Earlier.

In *Continental Can*, the '139 patent was broadly construed and held to be infringed by a plastic container and a plastic lid having a notched bead even though the dry container and lid did not seal. Infringement was predicated on liquid contents in the container blocking the notches and thus forming a seal.

The prior art cited in *Continental Can* did not include a plastic lid with a notched bead for use on a plastic cottage cheese container. The evidence in the present case establishes that Kent, not ITW as the *Continental Can* Court believed, was the first to develop, market and sell a vented all plastic cottage cheese package. The essential structure and function of the Kent pack-

* See Fig. 4 reproduced on Plate II.

age is identical to the accused infringing package in *Continental Can*; both packages had notched lids that would vent air during capping yet narrow enough to prevent liquid leakage. This was the basis upon which ITW in *Continental Can* asserted infringement.

"The petitioner having sought and obtained a broad construction of his claims cannot now narrow it so as to avoid anticipation." *Smith v. Hall*, 301 U. S. 216 (1937).

The Court of Appeals found Kent to be prior art to the '139 patent but then erroneously distinguished Kent on a "three seal" argument contrived by ITW's counsel. The Court of Appeals erroneously asserted that Petitioner did not directly address this argument in its Reply Brief. Possibly, the Court did not read pages 22-23 of our Reply on this point. There is no evidence in this case that any package ever made by Kent had such a "three seal" feature. The evidence is wholly to the contrary. This completely unfounded argument is totally predicated on an early designer's conceptual drawing that was never used to make anything except an argument. Kent witnesses testified that the actual packages leaked the liquid contents of the packaged cottage cheese when the notches in the lid bead were too wide and the packages did not leak when the vents were made smaller. The Kent witnesses further testified that narrower notches in the lid bead prevented trapping air and solved the lid popping problem.

The Court's "three seal" error was further compounded by a holding that it was not reversible error for the District Court to refuse to allow this Petitioner to make a comparison between the prior art Kent package and the infringing package from *Continental Can*. The lower court's holding is plain error, contrary to the Federal Rules of Evidence and contrary to the decision of this Court in *Knapp v. Morss*, *supra*.

5. A Combination of Old Elements in '139.

Each and every element of the '139 venting patent can be found in the prior art Kent Plastic package. Yet under the

Seventh Circuit's application of the *Rovico* rule and the lower court's erroneous interpretation of the evidence, this Petitioner has been denied due process and the step-by-step analysis required by this Court in *Graham v. Deere*, *supra*, at 17. The combination of elements in the infringing *Continental Can* package are identical to those found in the prior art Kent package.* Additional new prior art was also introduced, that demonstrated trapping air in packages was a problem long recognized by the art (e.g., DX 345, tab 13).

This Court has repeatedly emphasized that courts should scrutinize combination claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, *supra*, at 152. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, *supra*, and *Sakraida v. Ag Pro, Inc.*, *supra*. Under the standard laid down in these cases, the '139 patent is invalid because there is no unobvious result, indeed there is nothing new.

Here, no such scrutiny was observed. In fact, no meaningful analysis of the prior art taken as a whole was made by either court. The Court of Appeals in its Opinion faulted the District Court's analysis of the prior art; however, the Court of Appeals itself failed to even mention Petitioner's newly cited art with the exception of Kent much less consider the art cited in the prior *Continental Can* case. Here, Petitioner brought forth for the first time prior art (Kent) that was structurally identical to the alleged invention but that was dismissed piece-meal without consideration of the other prior art taken as a whole (DX 345).

* See illustrations on Plate III.

The application of the *Rovico* rule by the Court of Appeals, here, has effectively denied this Petitioner his day in Court. Further, unchecked application of the *Rovico* rule in the manner used by the Seventh Circuit will effectively evade the mandates of this Court, the "Due Process" clause of the Constitution and 35 U. S. C. §§ 103 and 112 of the Patent Act.

CONCLUSION.

For the reasons stated this Petition for Certiorari should be granted.

Respectfully submitted,

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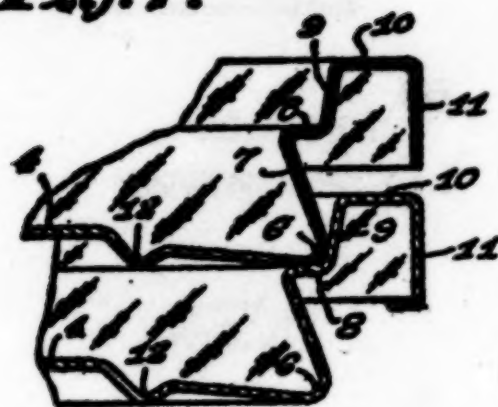
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E. T. ALDINGTON
SELF-CONFORMING COVER
FOR CONTAINERS

Fig. 7.



A. FLACK
NESTABLE PLASTIC
CONTAINERS

Fig. 1.

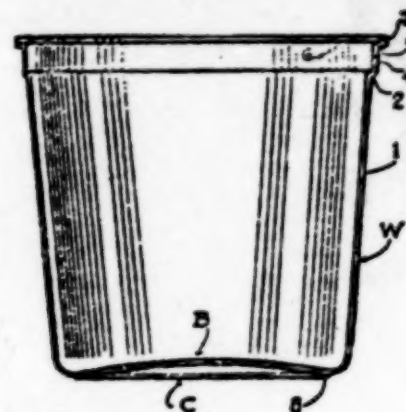
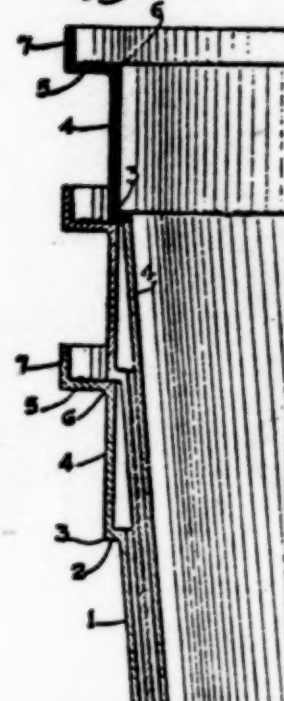
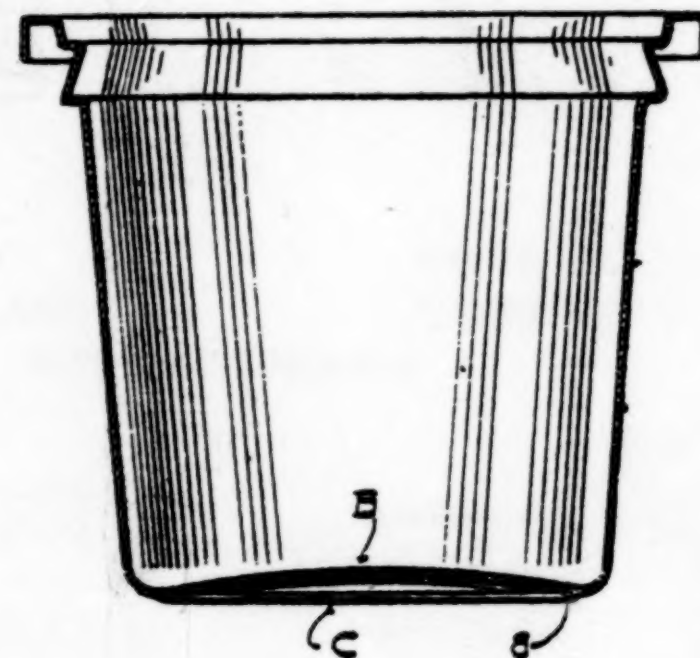


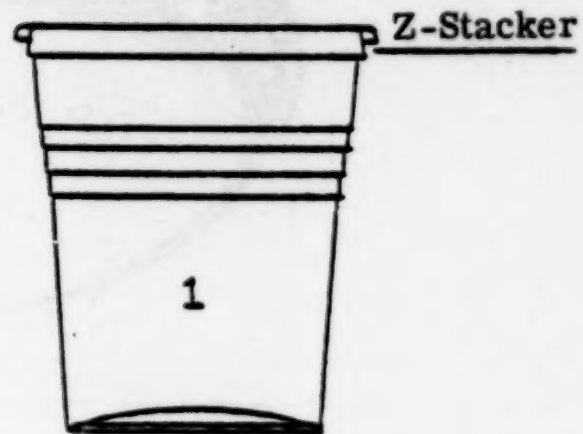
Fig. 2.



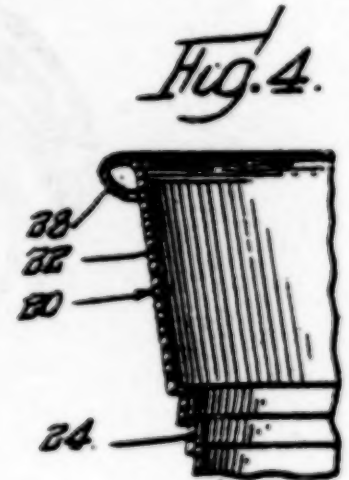
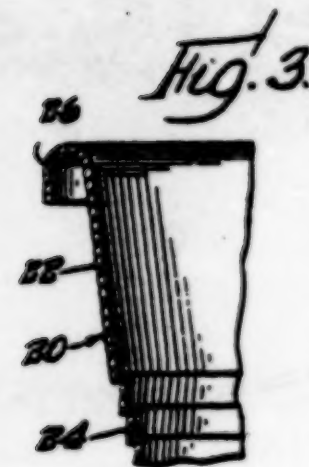
THE COMBINATION
OF
FLACK & ALDINGTON



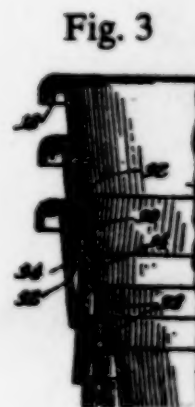
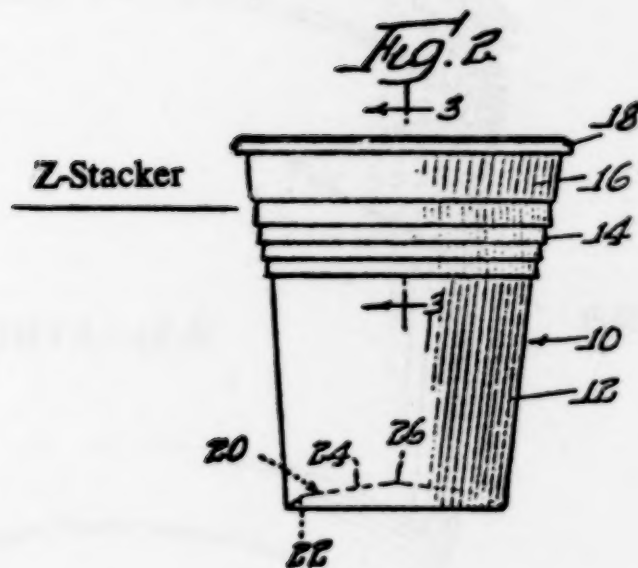
EDWARDS' ABANDONED
RIM STACKER



B. EDWARDS — U. S. 3-096,546

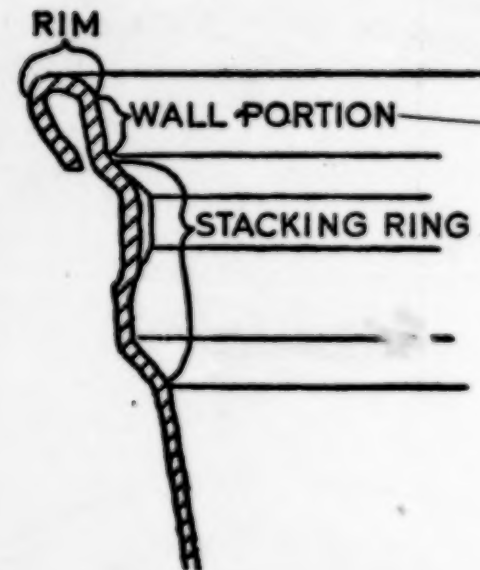


EDWARDS'
"INVENTIVE" CUP

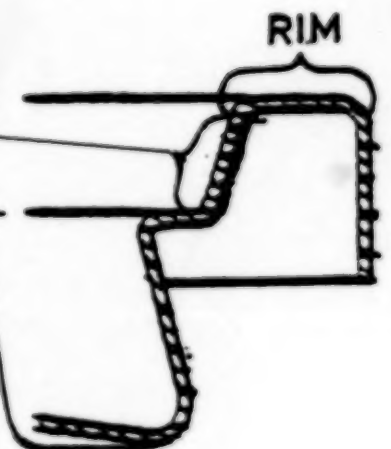


ACCUSED
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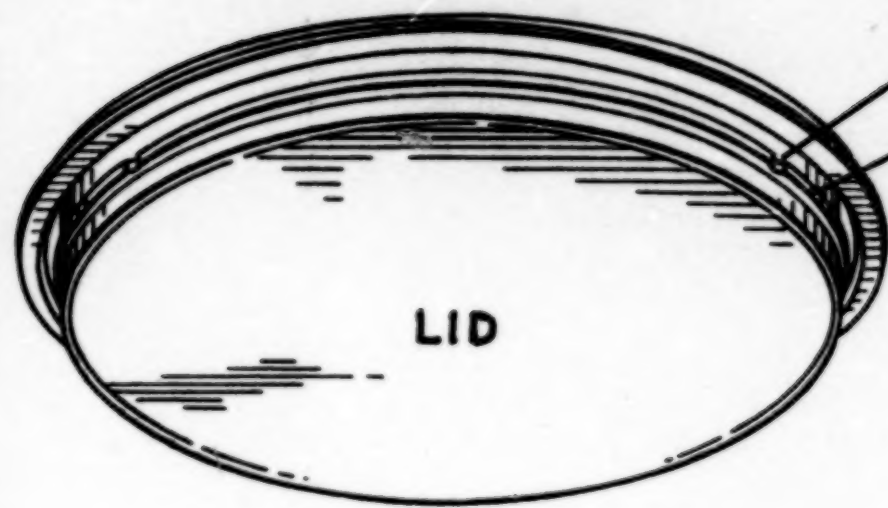
WITH ITW LEGENDS



PRIOR ART
ALDINGTON



KENT PLASTICS



VENTING
NOTCHES

BEAD

CONTINENTAL CAN

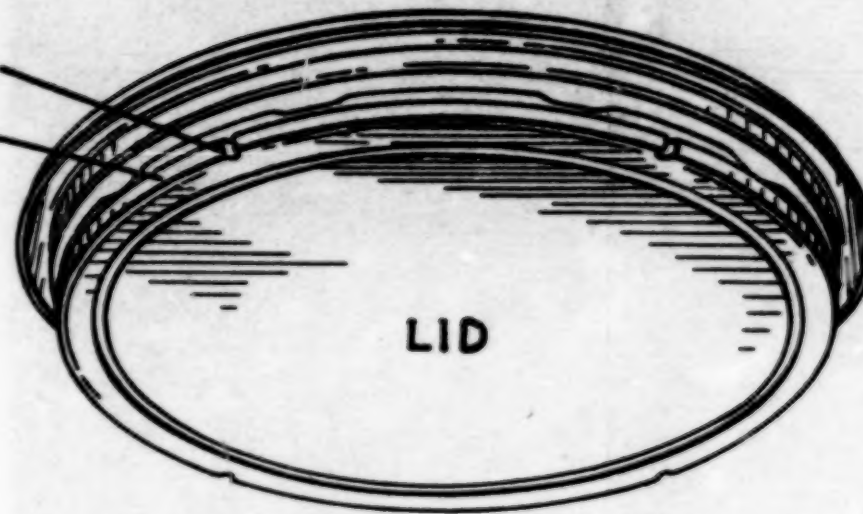
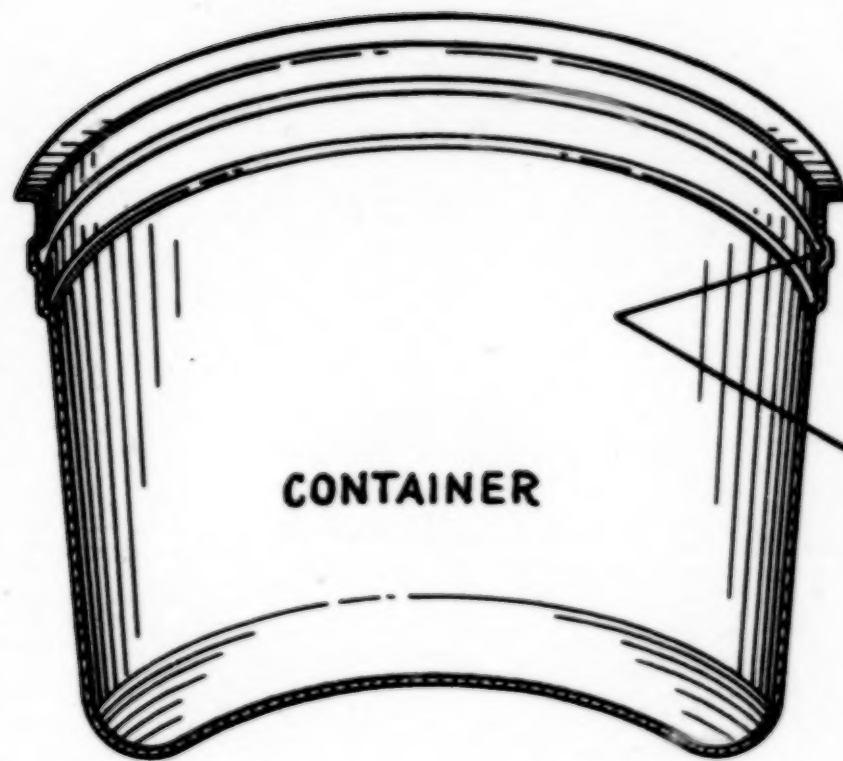


PLATE III



GROOVE

